

Appl. No. 10/790,394  
Response to Office Action mailed May 1, 2007

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REMARKS

The final Office Action was issued on pending claims 1-15, 24 and 26, of which claims 1, 2, 6, 8, 9, 13, 24 and 26 are under consideration and claims 3-5, 7, 10-12 and 14-15 are withdrawn from consideration. Claims 1, 2, 6, 8, 9, 13, 24 and 26 stand rejected. In this Response, claim 1 has been amended, claims 27 and 28 have been added and no claims have been cancelled. Thus, claims 1-15, 24 and 26-28 are pending in the application and claims 1, 2, 6, 8, 9, 13, 24 and 26-28 are under consideration.

Applicants thank the Examiner for the telephone interview with Applicants' Representative on July 10, 2007. During the interview the Examiner stated this after final Response would be entered and considered. Independent claim 1 is being amended as discussed during the interview.

Applicants thank the Examiner and appreciate that the Examiner stated he would call Applicants' Representative to discuss any issues with this Response.

Declaration of Tim Russell under 37 CFR §1.132

Applicants submit the enclosed Declaration of Tim Russell under 37 C.F.R. §1.132 (the Russell Declaration) in support of this Response. The Russell Declaration is timely submitted because there is a good and sufficient reason for submission of the Russell Declaration in response to the final Office Action. See M.P.E.P. §716.01.

Applicants' Representative requested a telephone interview with the Examiner after issuance of the non-final Office Action dated October 13, 2006 to assist with a response to that Office Action. The Examiner required submission of a written response to the non-final Office Action prior to conducting an interview. The Examiner stated he would call Applicants' Representative for the interview if that Response did not place the application in condition for allowance before issuing a final Office Action. However, a final Office Action was issued without the Examiner contacting Applicants' Representative for the interview. Applicants relied on the Examiner's representation that there would be an interview prior to issuing the final Office Action, and that is a good and sufficient reason why the enclosed Russell Declaration was not submitted earlier. Applicants' Representative thanks the Examiner for the interview after the

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final Office Action. In view of that interview, Applicants submit the enclosed Russell Declaration in support of this Response.

Another good and sufficient reason for submitting the Russell Declaration at this time is that the rejections in the final Office Action based on Boyer in view of Driskell et al. were presented for the first time in the final Office Action. The Russell Declaration was not submitted earlier to traverse those rejections because those rejections were not present prior to the final Office Action.

Therefore, the Russell Declaration is timely submitted because there is a good and sufficient reason for submission of the Russell Declaration in response to the final Office Action.

#### Claim Rejections – 35 USC §103

In the Office Action at page 2, claims 1, 6, 8, 13, 24 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boyer (US 6,390,234) or O'Dell (US 6,533,066) in view of Driskell et al. (US 2003/0069557). At pages 2 and 3 of the Office Action claims 2 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boyer or O'Dell and Driskell et al. and further in view of Piper (US 4,746,769), Chang et al. (US 6,238,167) or Silverberg (US 6,085,802). Applicants respectfully disagree.

During the interview, the Examiner asserted that there was no invention in the lanyard itself, and the invention, if any, only lies in the method of making the lanyard. Applicants strongly and respectfully disagree and would like to respond to that assertion. Applicants agree with the Examiner that there is an invention in the methods of making the lanyard. However, Applicants believe there is also an invention in the lanyard itself.

Claim 1 recites structure of a lanyard which Applicants believe is novel and unobvious, i.e., patentable. The structure of the lanyard of claim 1 includes "a heat shrunken substantially inelastic elongation member extending along an inside of the outer sheath." The heat shrunken substantially inelastic elongation member is clearly part of the structure of the lanyard and is not a method step. Furthermore, claim 1 calls for "wherein the heat shrunken elongation member has a first state prior to heat shrinking of being not heat shrunken and a second state after heat shrinking, and wherein the load-supporting outer sheath and the heat shrunken elongation

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member in the first state are formed substantially simultaneously together as a one-piece webbing." (Emphasis supplied). That recitation of claim 1 clearly recites the structure of the one-piece webbing and is not a method step. Although not specifically mentioned here, the other portions of claim 1 also recite structure and not method steps. The structure of the lanyard is the subject matter of the claims in the present application regardless of any process or method of making the lanyard.

Many inventions can have structural aspects which are patentable as well as method aspects which are patentable. Merely because an invention has a patentable method aspect does not preclude patentability of the structural aspect. In the present case, Applicants' invention has both structural and method aspects which are patentable. Regarding claim 1, the prior art - in a single reference or combination of references - simply does not have the structure of Applicants' claimed lanyard.

Turning to claim 1, claim 1 has been amended as discussed during the interview with the Examiner to more clearly recite that the heat shrunken substantially inelastic elongation member is inelastic after being heat shrunken. Specifically, claim 1 calls for "a heat shrunken substantially inelastic elongation member extending along an inside of the outer sheath." (Emphasis supplied). Claim 1 also calls for "wherein the heat shrunken elongation member is elongatable and substantially inelastic in the second state," the second state being after heat shrinking. The amendment to claim 1 is supported by the application as originally filed. As discussed in the previous Response to Office Action submitted February 13, 2007, the application as originally filed supports the elongation member being substantially inelastic. For the same reasons the application as originally filed clearly supports the substantially inelastic elongation member being inelastic after heat treatment of the elongation member.

One important feature of the shock absorbing lanyards of the present application is the heat shrunken substantially inelastic elongation member being the inelastic after heat shrinking. See the entire Russell Declaration, for example paragraph 5.

Turning to Boyer and O'Dell, the Office Action acknowledges that those references do not have Applicants' heat shrunken elongation members. Accordingly, Boyer and O'Dell do not have Applicants' claimed structure of the heat shrunken substantially inelastic elongation

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member extending along an inside of the outer sheath. Furthermore, Applicants submit Boyer and O'Dell do not have Applicants' claimed structure of the heat shrunken elongation member being elongatable and substantially inelastic in the second state, i.e. after heat shrinking.

As to Driskell et al., Driskell et al. pertains to an absorbent garment 20, i.e. a diaper. Initially, Applicants respectfully submit that it would not be obvious to one of ordinary skill in the art of lanyards to look to diapers for modifying lanyards to achieve Applicants' claimed invention. Applicants respectfully submit that it would not be obvious to one of ordinary skill in the art to combine the Driskell et al. diaper with the lanyards of Boyer or O'Dell. See the Russell Declaration paragraphs 25-31, 36 and 37. However, even if Driskell et al. is properly combinable with either of those references, the combination does not result in Applicants' claimed invention. See the Russell Declaration paragraphs 25 and 32-37.

The Driskell et al. absorbent garment 20 (diaper) has longitudinal strands 44 which are made of an elastomeric material between an outer layer 22 and an inner layer 24 as shown in Fig. 1. The elastomeric material is heat-shrinkable; however, when the elastomeric material is shrunk it is relatively stable and elastic. See Driskell et al. paragraphs [0044] and [0045]. Driskell et al. intends for the heat-shrinkable elastomeric material to remain elastic after heat shrinking because the elastomeric material is used to form expandable gathers in side margins 34 and 36 of the absorbent garment 20. The side margins 34 and 36 are intended to be elastic to encircle legs of a wearer during use. See Driskell et al. paragraphs [0041] and [0044]. Accordingly, Driskell et al. has elastic heat-shrinkable elastomeric strands which are elastic after heat shrinking. Conversely, Applicants' claim 1 calls for "a heat shrunken substantially inelastic elongation member extending along an inside of the outer sheath." Driskell et al. simply does not have the structure of a heat shrunken substantially inelastic elongation member. See also the Russell Declaration paragraphs 25-31, 36 and 37.

Furthermore, it would not be obvious to modify the Driskell et al. elastomeric longitudinal strands 44 of the diaper 20 to be inelastic after heat treating. If the longitudinal strands 44 were inelastic after heat treating, then the diaper 20 would not have expandable gathers in the side margins 34, 36 for the wearer's legs. The modified non-expandable leg gathers would make the diaper 20 difficult or impossible to wear. The diaper 20 may be either too loose or too tight around the wearer's legs. The diaper 20 would likely not be wearable at all

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or, if wearable, the diaper may be ineffective for its intended purpose. See also the Russell Declaration paragraphs 25 and 32-37.

Thus, even if Driskell et al. is combined with Boyer or O'Dell, the combinations do not result in the Applicants' invention as claimed in claim 1.

As to independent claim 8, claim 8 calls for, "heat-shrunk elongation yarns inside of the tubular-shaped webbing, the heat-shrunk elongation yarns being elongatable and substantially inelastic," among other features. (Emphasis supplied). Accordingly, claim 8 is distinguished from Boyer or O'Dell in view of Driskell et al. for the same reasons claim 1 is distinguished from those references.

Therefore, independent claims 1 and 8 are allowable. The dependent claims are allowable at least for the same reasons that their respective independent claims are allowable.

Yet another reason claim 1 is allowable is that claim 1 calls for "wherein the heat shrunken elongation member has a first state prior to heat shrinking of being not heat shrunken and a second state after heat shrinking, and wherein the load-supporting outer sheath and the heat shrunken elongation member in the first state are formed substantially simultaneously together as a one-piece webbing." (Emphasis supplied). Independent claim 8 recites similar text. The Office Action does not even identify this claimed structure in Boyer, O'Dell or Driskell et al. As to Boyer, Boyer does not describe the how its shock-absorbing band 40, particularly the tubular sleeve 42 and the stretchable insert 44, is structurally made. As to O'Dell, the O'Dell shock absorbing lanyard 20 is made by adjusting the relative lengths of POY fibers 36 relative to a sheath 22 by withdrawing the POY fibers 36 from the sheath 22 and gathering or overlapping the excess sheath material. Figs. 3, 4, 6, 7, 8, 11, 13 and 15 of O'Dell all show lanyards having excess sheath material of the outer sheath gathered or overlapped at 42. See O'Dell column 5, lines 12-47. As to Driskell et al., Driskell et al. describes securing the elastic strands 44 – which are initially completely separate from the outer and inner layers 22, 24 – to the outer and inner layers 22, 24. See Driskell et al. paragraph [0044]. Nowhere does Driskell et al. describe forming the outer layer 22, the inner layer 24 and the elastic strands 44 substantially simultaneously together as a one-piece webbing. Accordingly, if the heat shrinkable elastic strands 44 of Driskell et al. are combined into Boyer or O'Dell, the combinations would not

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result Boyer or O'Dell having the structure of the load-supporting outer sheath and the substantially inelastic elongation member formed substantially simultaneously together as a one-piece webbing as claimed by Applicants.

Therefore, claims 1 and 8 are allowable for those additional reasons. Thus, Applicants submit that §103 rejections should be withdrawn.

Objective Evidence of nonobviousness

Applicants further submit the enclosed Russell Declaration containing objective evidence of nonobviousness to traverse the §103 rejections. Applicants kindly note that the Russell Declaration must be considered by the Examiner as required by M.P.E.P §716.01(B).

The Russell Declaration establishes the following objective evidence of nonobviousness of the invention as claimed in claims 1 and 8.

1. The shock absorbing lanyards exhibit unexpected results. See the Russell Declaration at paragraphs 6-8.
2. The shock absorbing lanyards have experienced remarkable commercial success during a short time period. See the Russell Declaration at paragraphs 9-16.
3. There has been long-felt, unresolved needs for improved safety lanyards in the fall protection industry. See the Russell Declaration at paragraphs 17-21.
4. The shock absorbing lanyards having a heat shrunken inelastic elongation member was initially met with skepticism by an expert in the industry. See the Russell Declaration at paragraphs 22-24.

In view of the Russell Declaration Applicants submit the dependent claims are not obvious considering Boyer or O'Dell in view of Driskell et al. Thus, Applicants submit that §103 rejections should be withdrawn.

New Claims 27 and 28

New dependent claims 27 and 28 have been added and depend from claims 1 and 8 respectively. Claims 27 further defines the heat-shrunken elongation member as being free from

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being secured to the load-supporting outer sheath between the first and second connection locations. Similarly, claim 28 further defines the heat-shrunken elongation yarns as being secured to the tubular-shaped webbing at spaced apart connection locations and the heat-shrunken elongation yarns are free from being secured to the tubular-shaped webbing between the connection locations. Claims 27 and 28 are supported by the application as originally filed at page 7, lines 15-26.

Applicants submit new claims 27 and 28 are allowable. The Driskell et al. absorbent garment 20 (diaper) has elasticized leg openings defined by opposed side margins 34, 36. See Fig. 1 of Driskell et al. The elasticized leg openings can be made by providing elastic strands 44 between an outer layer 22 and an inner layer 24 and attaching the elastic strands 44 to the outer and inner layers 22, 24. See Driskell et al. paragraph [0044]. Nowhere does Driskell et al. indicate that securing the elastic strands 44 to the outer and inner layers 22, 24 includes securing the elastic strands 44 to the outer and inner layers 22, 24 at a pair of connection locations and leaving the elastic strands 44 free from being secured to the outer and inner layers between the pair of connection locations.

Thus, Applicants submit claims 27 and 28 are allowable.

CONCLUSION

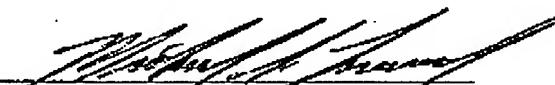
For the foregoing reasons, Applicants submit that the patent application is in condition for allowance and request a Notice of Allowance be issued.

Respectfully submitted,

EVEREST INTELLECTUAL PROPERTY LAW GROUP

Date: July 25, 2007

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